

TAB 2

The opinion in support of the decision being entered
today is not binding precedent of the Board.

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Paper No. 187

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ANDREW H. CRAGG and MICHAEL D. DAKE,

Junior Party,
(Application 08/461,402),¹

MAILED

v.

JUL 27 2001

ERIC C. MARTIN,

Junior Party,
(Application 5,575,817),²

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

v..

THOMAS J. FOGARTY, JAY A. LENKER,
TIMOTHY J. RYAN and KIRSTEN FREISLINGER,

Senior Party,
(Application 08/463,836).³

Patent Interference No. 104,192

¹ Filed 06/05/95. Accorded the benefit of application 08/317,763, filed October 4, 1994, now Patent No. 5,609,627, and application 08/312,881, filed September 27, 1994. The real party in interest is Boston Scientific Technology, Inc.

² Based on application 08/293,541, filed August 19, 1994.

³ Filed June 5, 1995. Accorded the benefit of application 08/255,681, filed June 8, 1994. The real party in interest is Medtronic Aneurx, Inc.

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Interference No. 104,192
Cragg v. Martin v. Fogarty

Before McKELVEY, Senior Administrative Patent Judge, and SCHAFER,
LEE and MEDLEY, Administrative Patent Judges.

LEE, Administrative Patent Judge.

FINAL DECISION AND JUDGMENT

Introduction

When this interference was declared on April 23, 1998, current junior party Cragg was then senior party Goicoechea. Because of the granting of a motion to correct inventorship in related Interference No. 104,083 for application 08/461,402, the same application that is involved in this interference, co-inventors George Goicoechea, John Hudson, and Claude Mialhe were deleted and the only remaining inventors in that application are Andrew H. Cragg and Michael D. Dake. Thus, party Goicoechea became party Cragg. Any reference to party Goicoechea should be understood as a reference to party Cragg.

A decision on the parties' preliminary motions was rendered on February 11, 2000 (Paper No. 108), after which party Fogarty filed a miscellaneous motion (Paper No. 112) for leave to file, out of time, a preliminary motion 12 to attack the benefit accorded party Cragg of European Applications EP94400284.9 and EP94401306.9. The motion for leave as well as the preliminary motion 12 (Paper No. 113) were granted by a panel consisting of administrative patent judges Schafer and Lee (Paper No. 130).

Interference No. 104,192
Cragg v. Martin v. Fogarty

The decision on Fogarty's preliminary motion 12 was adhered to on reconsideration (Paper No. 138) by a panel consisting of Senior Administrative Patent Judge McKelvey, and Administrative Patent Judges Schafer and Lee. This interference was re-declared in Paper No. 131 to change the junior/senior status of parties Cragg and Fogarty, with Cragg now being junior party.

Junior party Martin did not file a preliminary statement. It has indicated to the administrative patent judge to which this case was assigned that it did not want to participate in this interference except to "ride along" for the possibility that (1) the only interference-in-fact is determined to be between parties Cragg and Martin (a Cragg contention); and (2) that party Cragg will be deprived of its accorded benefit date (a Fogarty contention) and cannot demonstrate a sufficiently early date to prevail over Martin.

Because junior party Cragg filed no case-in-chief during the priority phase of this proceeding, it was placed under an order to show cause why judgment should not be entered against Cragg. Party Cragg requested final hearing for review of the Board's decision on Cragg's preliminary motions 1 and 2 and on Fogarty's preliminary motion 12. According to party Cragg it should not have been made a junior party and thus need not have had to put on a priority case in the first instance. Party Fogarty

Interference No. 104,192
Cragg v. Martin v. Fogarty

requested review of the Board's decision on its preliminary motions 8 and 10. Oral argument was made on February 28, 2001, before administrative patent judges Schafer, Lee and Medley.

Findings of Fact

The below-listed findings as well as those contained in the discussion portion of this opinion are supported by a preponderance of the evidence:

1. This interference was declared on April 23, 1998, between three parties, Martin, Fogarty, and Goicoechea (now Cragg).
2. The involved patent of Martin is Patent No. 5,575,817, based on application 08/293,541, filed August 19, 1994.
3. The involved application of Cragg is application 08/461,402, filed June 5, 1995.
4. The involved application of Fogarty is application 08/463,836, filed June 5, 1995.
5. At the time of declaration of this interference, the named inventors of Cragg's involved application 08/461,402 were George Goicoechea, John Hudson, Claude Mialhe, Andrew H. Cragg, and Michael D. Dake.
6. Cragg's application 08/461,402, was also involved in a related interference, Interference No. 104,083, between parties Cragg and Martin but not Fogarty, wherein a motion to correct

Interference No. 104,192
Cragg v. Martin v. Fogarty

inventorship was granted, deleting George Goicoechea, John Hudson, and Claude Mialhe as co-inventors, and leaving only Andrew H. Cragg and Michael D. Dake.

7. This interference was re-declared on June 2, 1999 (Paper No. 106) to reflect that only Andrew H. Cragg and Michael D. Dake are named inventors in Cragg's involved application.

8. Independent claim 1 of Martin's involved patent reads identically as the count in related Interference No. 104,083, and judgment was entered against party Martin in that interference on March 10, 1999.

9. Claim 2 of Martin's involved patent depends from claim 1, and if re-written in independent form it would read the same as the count in this interference.

10. The count of this interference reads as follows (Paper No. 16):

An apparatus for reinforcing a bifurcated lumen comprising:

a first section, configured to be positioned within the lumen, comprising:

an upper limb, configured to fit within the lumen upstream of the bifurcation;

a first lower limb, configured to extend into a first leg of said bifurcation when said first section is positioned in the lumen, and

Interference No. 104,192
Cragg v. Martin v. Fogarty

a second lower limb, shorter than said first lower limb, and configured so that when said first section is positioned in the lumen, said second lower limb does not extend into a second leg of said bifurcation,

and further comprising

a second section configured to be positioned separately within the lumen and joined to said second lower limb of the first section, effectively extending said second lower limb into said second leg of said bifurcation.

11. Cragg's preliminary statement identifies only Michael D. Dake as the inventor of the subject matter of the count.

12. After the rendering of the Board's decision on preliminary motions (Paper No. 108) and subsequent service of the preliminary statement of party Cragg, Cragg filed a miscellaneous motion to amend or correct its preliminary statement to identify Andrew H. Cragg and Michael D. Dake as co-inventors of the subject matter of the count. (Paper No. 117).

13. Cragg's motion to amend was denied. (Paper No. 130). A written opinion explaining the basis of that denial followed. (Paper No. 140). Cragg requested reconsideration. The original decision was adhered to on reconsideration. (Paper No. 146).

14. Cragg has not sought review of the Board's denial of Cragg's motion to amend or correct its preliminary statement to name both Andrew H. Cragg and Michael D. Dake as inventors.

Interference No. 104,192
Cragg v. Martin v. Fogarty

15. Upon declaration of this interference, Cragg was accorded benefit of U.S. application 08/317,763, filed October 4, 1994, European application EP94400284.9, filed February 9, 1994, and European application EP94401306.9, filed June 10, 1994. The European applications did not identify any inventor and were filed by the entity MINTEC SARL.

16. Based on representations from individuals associated with party Cragg, party Fogarty regarded as true, until the service of party Cragg's preliminary statement, that European applications EP94400284.9 and EP94401306.9 were filed by MINTEC SARL on behalf of inventors Goicoechea, Hudson, Mialhe, and Cragg. (Fogarty Preliminary Motion 12, Fact No. 5 - not disputed by Cragg).

17. Michael D. Dake made an assignment of rights, including his interests in the invention covered by Cragg's involved application relating to a bifurcated stent-graft, to MinTec, Inc., for a one time payment of eight hundred thousand U.S. dollars (U.S. \$800,000) and other considerations, on May 6, 1996, with a stated effective date of April 30, 1996. (Cragg Exhibit 1025, CE-1025). The date of assignment was nearly two years and three months from the date of filing of EP94400284.9 on February 9, 1994, and nearly two years from the date of filing of EP94401306.9 on June 10, 1994.

Interference No. 104,192
Cragg v. Martin v. Fogarty

18. Parties Cragg and Fogarty evidently treat, without dispute, that MinTec, Inc. and MINTEC SARL are related entities such that an assignment of interest to the former means the latter is an "assign."

19. Andrew H. Cragg made an assignment of rights, including his interests in the invention covered by Cragg's involved application relating to a bifurcated endoluminal prosthesis, to MINTEC, INC. on August 22, 1994. (Cragg Exhibit 1021, CE-1021). The date of assignment was six months after the date of filing of EP94400284.9 on February 9, 1994, and two months after the date of filing of EP94401306.9 on June 10, 1994.

Discussion

A. Fogarty's Preliminary Motion 12

In the "Relief Requested" portion of Fogarty's preliminary motion 12, it is stated:

Fogarty moves under 37 CFR § 1.633(g) to deny the senior party the benefit of EP94400284.9 and EP94401306.9 on the grounds that neither application was filed by (i) the individual now identified as the inventor or (ii) on his behalf by his legal representatives or assigns.

The statutory basis of Fogarty's preliminary motion 12 is 35 U.S.C. § 119, which states, in pertinent part:

Interference No. 104,192
Cragg v. Martin v. Fogarty

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; (Emphasis added.)

As the motion panel's decision on reconsideration (Paper No. 138) states on page 3, a statement with which we agree and adopt herein:

We interpret the above-quoted "any person who has, or whose legal representatives or assigns have" language as meaning that the previously filed foreign application ~~must have been filed by the person or one who was,~~ at the time of filing of the previously filed foreign application, already a legal representative or assign of that person. This view is necessary to ensure a link between the presently involved application and the earlier filed foreign application with respect to the particular inventor. A contrary interpretation would cause entitlement to benefit to be negotiable as a commodity between unrelated entities. Note that if party Martin or party Fogarty now assigned its involved patent or application to MINTEC, that does not and should not mean party Martin or party Fogarty's involved case should suddenly be entitled to the benefit of the earlier filing dates of party Cragg's European applications, on the basis that the European applications were previously filed by MINTEC who is now the assignee of party Martin or party Fogarty's involved patent or application.

Interference No. 104,192
Cragg v. Martin v. Fogarty

Our view is consistent with the opinion of the Court of Customs and Patent Appeals in Vogel v. Jones, 486 F.2d 1068, 1072, 179 USPQ 425, 428 (CCPA 1973), wherein the court determined that a foreign application made by the assignee of a U.S. applicant, on behalf of one other than the United States inventor, is irrelevant to the rights of priority of the U.S. inventor. The Vogel case concerns 35 U.S.C. § 119, not 35 U.S.C. § 116 or § 120. Contrary to a suggestion by party Cragg in its reply brief at final hearing, Vogel has not been made outdated by statutory amendments to 35 U.S.C. § 116 and § 120 in 1984. The inventive entity may not always be identical between a U.S. application as a whole and an ancestral corresponding application in a foreign application. E.g., Reitz v. Inoue, 39 USPQ2d 1838, 1840 (Bd. Pat. App. & Int. 1996) ("the proposition that the inventive entity must be the same in both the foreign and the corresponding U.S. application in order to obtain benefit can no longer be accepted, if it ever was, as a hard and fast rule in view of the liberalization of the requirements for filing a U.S. application as joint inventors wrought by the 1984 amendment of 35 U.S.C. § 116."). But with regard to any particular invention at issue or involved in an interference, 35 U.S.C. § 119 still includes the language concerning filing in a foreign country by

Interference No. 104,192
Cragg v. Martin v. Fogarty

assigns or legal representatives of the one who files for that invention in the United States.

We have reviewed Schmitt v. Babcock, 377 F.2d 994, 153 USPQ 719 (CCPA 1967), a case mentioned by Cragg during oral argument at final hearing as somehow being in support of its position, but it does not help Cragg's position. The Schmitt case, from a pre-1984 era, relates to an inconsistency or disagreement in inventorship between the U.S. application and the foreign application and a resolution of that disagreement prior to accordance of benefit. Here, inconsistency or disagreement in inventorship is not the issue. Nothing in Schmitt purports to not recognize the filing by assigns requirement of 35 U.S.C. § 119. Even if it does, that would be contrary to the Vogel case which is later in time and thus takes precedent over Schmitt.

It is not in dispute that the assignment from Michael D. Dake to Mintec, Inc. occurred subsequent to the filing of the two European applications. In its request for reconsideration (Paper No. 137) of the granting of Fogarty's preliminary motion 12, on pages 4-5, Cragg stated:

Mintec, the applicant in the EP applications in question, was the assignee of both Dr. Cragg and Dr. Dake, albeit the assignment by Dr. Cragg came several months after those applications had been filed and the assignment by Dr. Dake came more than a year after they had been filed.

Interference No. 104,192
Cragg v. Martin v. Fogarty

Note Cragg's exhibit CE-1025, an assignment document from Mr. Michael D. Dake to MinTec, Inc., which was executed on May 6, 1996, more than two years after the filing of EP94400284.9, and nearly two years after the filing of EP94401306.9.

Cragg's brief at final hearing does not appear to argue that under 35 U.S.C. § 119, a subsequent assignment puts an assignee in the same position as if it were a "legal representative" or "assign" of the inventor at a previous time when a foreign application for the same invention was filed by that assignee. In any event, that argument, if made, would be rejected because it ignores plain statutory language to the contrary. Cragg has not set forth evidence of legislative history which clearly indicates that the statute does not mean what it plainly says.

Two new arguments have been raised for the first time by party Cragg in its reply brief at final hearing, which should have been raised, if at all, in its opposition to Fogarty's preliminary motion 12. The first new argument is this: That the two European applications were filed by MINTEC SARL for an invention "actually made" by Michael D. Dake and Andrew H. Cragg, regardless of assignment, and that this should satisfy the filing by assign or legal representative requirement of 35 U.S.C. § 119. The second new argument is raised by the last sentence on page 10 of Cragg's reply brief, which reads: "There is no requirement

Interference No. 104,192
Cragg v. Martin v. Fogarty

either in Section 119 or in case law that the assignment must have been perfected before the EP applications were filed in order to rely on those applications for priority purposes." The statement implies that somehow there was at least an obligation of assignment which only was not perfected or formalized until after the filing of the European applications, and that this should satisfy 35 U.S.C. § 119.

The two new arguments were not in Cragg's opposition to Fogarty's preliminary motion 12, and still not in Cragg's request for reconsideration of the motion panel's decision on Fogarty's preliminary motion 12. They further still do not appear to be contained in Cragg's principal brief at final hearing.⁴ These arguments do not involve mere statutory construction, but are also fact determinative. If the new arguments were timely raised in Cragg's opposition to Fogarty's preliminary motion 12,

⁴ In its principal brief at final hearing on page 24, Cragg states: "Michael Dake had assigned his invention to Mintec and his collaboration with Andrew Cragg on the claimed invention prior to the filing of the EP applications is acknowledged. CE1025-1." This cannot be reasonably construed as an argument that the European applications filed by MINTEC SARL were for an invention actually made by Michael D. Dake and that that would satisfy the filing by assigns requirement of 35 U.S.C. § 119. In any event, raising such an argument for the first time in the principal brief at final hearing would nonetheless be untimely. Exhibit CE1025 also does not speak of any "collaboration" in the sense of there being a common goal, but mere discussion, consultation, and communication between Michael D. Dake and one or more of Messrs. Goicoechea, Cragg, and Hudson on a topic and "whatever contributions Dr. Dake may have made" (Emphasis added).

Interference No. 104,192
Cragg v. Martin v. Fogarty

pertinent facts could have been presented by both parties and Fogarty would have had an opportunity to explore and possibly discredit Cragg's assertions. We decline to entertain new arguments which were not presented in Cragg's opposition to Fogarty's preliminary motion 12.

Accordingly, we address only those arguments of Cragg which were raised in its opposition to Fogarty's preliminary motion 12.

Cragg argues that Fogarty's preliminary motion 12 was based on the representation in Cragg's preliminary statement that Michael D. Dake was the inventor for the subject matter of the count, and yet applicable precedent indicates that preliminary statements can only be used as an effective admission of the earliest or limiting date of invention provable by the party. Cragg's argument overlooks the 1984 changes to 35 U.S.C. § 116 and a corresponding change to 37 CFR § 1.622 regarding the content of preliminary statements. Cragg's argument is rejected.

There are many precedents, including the one cited by Cragg, Dewey v. Lawton, 347 F.2d 629, 631, 146 USPQ 187, 188 (CCPA 1965), which set forth the law that the date alleged in a party's preliminary statement only constitutes a limiting date. Thus, although a party may prove a date of invention that is earlier or later than the alleged date, it cannot be entitled to a date that is prior to the alleged date. Those cases all focus on

Interference No. 104,192
Cragg v. Martin v. Fogarty

the assertion of a date of invention and are not concerned with any identification of inventorship in the preliminary statement. Identification of inventorship did not become a requirement for preliminary statements until an amendment was made to 37 CFR § 1.622 in 1984 when Title 35, United States Code, was amended to provide that not every named inventor has to have made a contribution to every claim in a patent application. In pertinent part, 35 U.S.C. § 116 now states:

§ 116 Inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

Thus, when an application is filed which names multiple inventors, it is not known which inventor(s) contributed to the subject matter of which claims, or to the count in an interference, even though that information may be relevant to the requirements for accordancy of benefit in an interference. Rule 1.622, as amended in 1984, partially addresses that problem by requiring in a preliminary statement identification of the inventors of the subject matter of the count. It reads, in pertinent part:

Interference No. 104,192
Cragg v. Martin v. Fogarty

(a) A party's preliminary statement must identify the inventor who made the invention defined by each count and must state on behalf of the inventor the facts required by paragraph (a) of §§ 1.623, 1.624, and 1.625 as may be appropriate. . . .

Thus, the established precedent focusing on the effect of assertions of invention dates and not concerned with identification of inventorship are not apposite.

Cragg argues:

Rule 629, entitled "Effect of preliminary statement," is the only rule that addresses the consequences for allegations made in a preliminary statement, such consequences being limited to dates and issues of proving priority. Importantly, Rule 629 was amended at the same time Rule 622 was amended (in 1984) to require identification of inventors in a preliminary statement, but the amendment did not create an admission as to inventorship. Rule 629(a) states:

A party shall be held to any date alleged in the preliminary statement. Doubts as to definiteness or sufficiency of any allegation in a preliminary statement . . . will be resolved against the party filing the statement by restricting the party to its effective date or the latest date of a period alleged in the preliminary statement.
(Emphasis in original).

But again, this rule focuses on the effect of assertions as to a date of invention. It is concerned with ambiguities or indefiniteness in the assertion of a date of invention, and is not concerned with anything about the naming of inventors. The rule gives notice of something not so plain and obvious, i.e., that if a range of dates is asserted, then the party making the

Interference No. 104,192
Cragg v. Martin v. Fogarty

assertion is limited to the latest of such dates. For instance, if a party asserts that its invention was made in a period from January through March of a certain year, then the earliest date of invention the party is entitled would be March 31st.

There need not be a rule to state that which is plainly so, e.g., that what a party represents to an administrative tribunal or an opposing party can be used against the party if the representation is relevant to an adjudication of the party's own rights or the rights between the parties. Party Cragg is not charged with a crime and is not being interrogated in a criminal investigation such that it must be "mirandized" -- warned that anything it says can and will be used against it in a court of law -- before it makes a usable statement. What is important is that party Cragg be given an opportunity to explain or correct any misstatement it might have made and which has been relied upon by either the tribunal or the opposing party. There was ample such opportunity in this case.

Concurrently with the filing of its opposition to Fogarty's preliminary motion 12, Cragg filed a motion under 37 CFR § 1.628 to amend or correct its preliminary statement, to name not just Michael D. Dake as the only inventor of the subject matter of the count, but Andrew H. Cragg and Michael D. Dake as co-inventors. That was a full opportunity for party Cragg to present all the

Interference No. 104,192
Cragg v. Martin v. Fogarty

evidence it wanted to present on the issue, to demonstrate that it had made an error in only naming Michael D. Dake as the inventor of the subject matter of the count. That motion was denied on April 7, 2000, in Paper No. 130. Party Cragg requested reconsideration of that decision. The original decision was adhered to in a reconsideration decision on June 27, 2000, in Paper No. 146. Party Cragg has not sought review of that decision at final hearing.

Party Cragg further argues that the outcome here is unfair because as the original senior party it need not have filed a preliminary statement, and if it did not file a preliminary statement, then none of this would have ensued. The argument is rejected. If Cragg had not filed a preliminary statement, it would not have revealed information which ultimately led to its being deprived of benefit to the earlier filing dates of foreign applications. But this result is not unfair if, as it is here, all pertinent information were known, Cragg would not be entitled, under the law, to those earlier filing dates. Cragg had ample opportunity to show that the information it had first given was a mistake but failed to make a successful showing.

When 35 U.S.C. § 116 was amended in 1984 to permit co-inventors to be jointly listed as inventors without all of them having contributed to each and every claim in an application, a

Interference No. 104,192
Cragg v. Martin v. Fogarty

corresponding change was made in 35 U.S.C. § 120 (relating to benefit to the earlier filing date of previously filed United States applications) to require not identity but merely an overlap of inventor(s) between the application seeking benefit and the earlier filed application. The change to 35 U.S.C. § 120 was necessary because additional or non-overlapping inventors may be present due to the inclusion of claims drawn to different subject matter. No such change was necessary, however, with respect to the requirement of 35 U.S.C. § 119 that the person who has filed for a patent on an invention (here the invention of the count) must have previously regularly filed for a patent on the same invention in a foreign country, whether it is through legal representatives or assigns. Indeed, no change was made. The contexts and requirements of 35 U.S.C. § 119 and 35 U.S.C. § 120 are different. That Michael D. Dake being a sole inventor for the subject matter of the count is not a problem under 35 U.S.C. § 120 with respect to earlier filed United States applications does not mean Cragg can expect that it should also not be a problem insofar as benefit to foreign applications are concerned. Satisfaction of requirements under 35 U.S.C. § 120 entitles a party only to the earlier filing date of a previously filed United States application, not a foreign application.

Interference No. 104,192
Cragg v. Martin v. Fogarty

Alternatively, even assuming that Cragg's identification of Michael D. Dake as the only inventor for the subject matter of the count is a mistake and that Cragg has been allowed to amend its preliminary statement to identify both Andrew H. Cragg and Michael D. Dake as co-inventors of the subject matter of the count, that still does not help party Cragg in any meaningful way. Like Michael D. Dake, Andrew H. Cragg also did not assign his rights to MinTec, Inc. until after European application EP94400284.9 was filed on February 9, 1994, and European application EP94401306.9 was filed on June 10, 1994.

Cragg's Exhibit CE1021 is an assignment from Andrew Cragg, Claude Mialhe, George Goicoechea, and John Hudson to MINTEC, INC. It was executed by Andrew H. Cragg on August 22, 1994. Accordingly, MINTEC SARL was not an assign of either Michael D. Dake nor Andrew H. Cragg when it filed European applications EP94400284.9 and EP94401306.9. In that connection, we vacate the Board's previous finding in paragraph no. 7 of Paper No. 130 which stated: "The European applications EP94400284.9 and EP94401306.9 were filed by the assignee MINTEC SARL on behalf of inventors Andrew H. Cragg, George Goicoechea, John Hudson, and Claude Mialhe." That finding was made when the question of when Andrew H. Cragg assigned his rights was not an issue and also prior to party Cragg's representation to the Board in its request

Interference No. 104,192
Cragg v. Martin v. Fogarty

for reconsideration of the Board's granting of Fogarty's preliminary motion 12 that Andrew H. Cragg did not assign his rights to Mintec until several months after the European applications were filed. It lacks adequate basis in the record.⁵

Cragg still further argues that because it has been accorded benefit to the September 27, 1994 filing date of application 08/312,881 (granting of Cragg's preliminary motion 7) and because that application claims foreign priority to EP94400284.9 and EP94401306.9, which claim was granted by an examiner and not challenged in this interference, it still should have benefit of the filing dates of EP94400284.9 and EP94401306.9. The argument is without merit.

As the Board's decision on reconsideration (Paper No, 138) has stated on page 6:

Benefit to the two European applications cannot be obtained indirectly through the intermediate application 08/312,881, where the required overlap in inventor/filer is missing between the involved application and the European applications. This is not the same issue as satisfying the "filing within one year requirement of § 119" through an intermediary United States parent application.

⁵ Our authority and discretion to vacate the previous finding does not depend on whether Fogarty has asked the Board to reconsider the finding or when the request by Fogarty was made. We dismiss Cragg's argument that Fogarty was late in asking the Board to reconsider the previous finding.

Interference No. 104,192
Cragg v. Martin v. Fogarty

Cragg has offered no reason why the above-quoted analysis is erroneous. Here, we add the following observations.

Having benefit to the 9/27/94 filing date of application 08/312,881 means Cragg's involved application is deemed to have been filed not on the actual filing date of June 5, 1995, but on September 27, 1994. That brings Cragg's involved application much closer in time, by approximately 8 months, to any foreign application with respect to which it desires to be accorded benefit. With that shortening of the time gap, it is easier to satisfy the "within twelve months" time requirement of 35 U.S.C. § 119. It does not mean Cragg's involved application stands in the shoes or otherwise takes the place of the earlier filed domestic application. Benefit is still considered from the perspective of the claims or counts at issue in Cragg's involved application. Whether application 08/312,881 is entitled to benefit with respect to any claim contained therein is irrelevant, not at issue, and has not been determined in this proceeding. We are concerned with the claims of Cragg's involved application and the count in this interference. Fogarty is also correct in stating (Opp. Brief at 8):

Cragg's further argument on page 24 that 35 USC § 119 priority "has not been challenged" for Serial No. 08/312,881 also is irrelevant. In the context of an interference, rights under 35 USC § 119 and § 120 arise with respect to an embodiment within the count in a

Interference No. 104,192
Cragg v. Martin v. Fogarty

benefit application. Hunt v. Treppschuh, 523 F.2d 1386, 187 USPQ 426 (CCPA 1975). It is thus inaccurate to speak of priority between applications without reference to claims and/or a count. (Emphasis in original.)

For the foregoing reasons, Cragg has shown no error in the motion panel's granting of Fogarty's preliminary motion 12.

B. Fogarty's Preliminary Motions 8 and 10

In a decision mailed February 11, 2000 (Paper No. 108), the motions panel denied Fogarty's preliminary motion 8 under 37 CFR § 1.633(e)(1) which sought to declare another interference between proposed new claim 62 of an uninvolved application 08/684,508 of Fogarty and claim 89 of Cragg's involved application 08/461,402, and claim 1 of Martin's involved Patent No. 5,575,817. The decision gave two grounds for denying the preliminary motion:

(1) that the proposed new interference is barred by 35 U.S.C. § 135(b) because no claim which is the same or substantially the same as Martin's supposedly interfering patent claim 1 had been made by Fogarty within the critical one year period of 35 U.S.C. § 135(b); and

(2) that Fogarty failed to demonstrate that there is interference-in-fact between the allegedly interfering claims.

Fogarty argues, first, that we misapplied the requirements of 35 U.S.C. § 135(b) and that if correctly applied, the requirements of 35 U.S.C. § 135(b) are met. Fogarty further

Interference No. 104,192
Cragg v. Martin v. Fogarty

argues that there is no requirement in 37 CFR § 1.637 or otherwise, in connection with a preliminary motion to declare an additional interference, that the moving party has to demonstrate the existence of an interference-in-fact between the allegedly interfering claims.

1. Interference-In-Fact

According to Fogarty, it can find nothing in the interference rules which requires that in order for a preliminary motion to declare an additional interference to be granted, the preliminary motion must establish or demonstrate that an interference-in-fact exists between the claims sought to be involved in the additional interference. While there may be no express requirement, the decision on preliminary motions (Paper No. 108) on page 53, lines 18-22, states that the requirement is an implicit one:

Secondly, it is implicit that to demonstrate entitlement to the declaration of an additional interference as is requested in Fogarty's motion, Fogarty must demonstrate that there is interference-in-fact between Goicoechea's [Cragg after deleting Goicoechea as a co-inventor] application claim 89 and claim 62 of Fogarty's uninvolved application 08/684,508. (Emphasis added.)

Party Fogarty's brief at final hearing does not explain why it is not an implicit requirement that a motion to have an

Interference No. 104,192
Cragg v. Martin v. Fogarty

interference declared must demonstrate that the claims said to interfere with each other actually interfere with each other, i.e., that there is interference-in-fact between the allegedly interfering claims. Moreover, the very first sentence of 37 CFR § 1.637(a) is this: "A party filing a motion has the burden of proof to show that it is entitled to the relief sought in the motion." (Emphasis added).

We decline to simply take a moving party's word that one of its claims interferes with one or more claims of other parties. We reiterate our holding in the decision on preliminary motions that it is an implicit requirement for a preliminary motion to have another interference declared that the motion must demonstrate that there is interference-in-fact between the allegedly interfering claims. Fogarty's brief at final hearing does not address the point of "implicit" requirement and thus has not shown that the motion panel was erroneous.

Fogarty also asserts that in any event the Board's two-way interference-in-fact analysis follows the Trial Section's precedential decision in Winter v. Fujita, 53 USPQ2d 1234 (Bd. Pat. App. & Int. 1999), but that was not the criteria in October 1998 when preliminary motions were filed in this proceeding. We suppose that what Fogarty is arguing is that had it known of the two-way analysis requirement at the time it filed its preliminary

3 3

Interference No. 104,192
Cragg v. Martin v. Fogarty

motion 8, it could have tried to demonstrate satisfaction of the two-way requirement. That is true, but as was explained in our initial decision, Fogarty has failed to explain why there is interference-in-fact, in either direction, e.g., neither from Martin's claim 1 or Cragg's claim 89 to Fogarty's claim 62, nor from Fogarty's claim 62 to Martin's claim 1 or Cragg's claim 89.⁶ Note also that the declaration of an interference is a discretionary matter. See Ewing v. Fowler Car Co., 244 U.S. 1, 10-11 (1917) (explicitly rejecting the assertion of an applicant's right to declaration of an interference). It is not an abuse of discretion to not declare an interference where the moving party has not demonstrated that there is a conflict or interference-in-fact between opposing claims, regardless of whether the interference rules expressly require a demonstration of conflicting subject matter or interference-in-fact.

⁶ The motion panel's decision observed that Fogarty's position that Cragg's claim 89 and Martin's claim 1 are unpatentable over prior art while Fogarty's claim 62 is patentable over that same prior art is contrary to the position that Fogarty's claim 62 defines the same patentable invention as Cragg's claim 89 and Martin's claim 1. Fogarty's brief at final hearing points out that the motion panel rejected Fogarty's prior art argument and that Cragg has not sought review of that issue. But at best the circumstance pointed out by Cragg only eliminates an apparent inconsistency. It does not demonstrate affirmatively that the claims define the same patentable invention.

Interference No. 104,192
Cragg v. Martin v. Fogarty

2. 35 U.S.C. § 135(b) Bar

There is no dispute that Fogarty's amendment in its uninvolved application 08/684,508, proposing to add claim 62 to provoke an interference with claim 89 of Cragg's application 08/461,402 and claim 1 of Martin's Patent No. 5,575,817, is filed more than one year after the date of issuance of Martin's Patent No. 5,575,817. The question at issue is whether Fogarty had another claim, drawn to the same or substantially the same invention as Martin's claim 1, that was pending within one year subsequent to the date of issuance of the Martin patent. If so, claim 62 is not barred. If not, then claim 62 is barred.

In pertinent part, 35 U.S.C. § 135(b) states:

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

Even though the new interference proposed by Fogarty involves claim 1 of Martin's patent, Fogarty attempted to demonstrate that it had a claim drawn to substantially the same subject matter as Martin's claim 1 by showing that it was claiming, within the critical one year period, the same invention as Martin's claim 2. Martin's claim 2 depends from claim 1 and in independent form represents the count of this interference.

Interference No. 104,192
Cragg v. Martin v. Fogarty

In the motion panel's initial decision (Paper No. 108, pages 52-53), it was stated:

There is no indication anywhere by any party that Fogarty's uninvolved application 08/684,508 had a claim drawn to substantially the same subject matter as Martin's claim 2. While Fogarty's involved application [08/463,836] in this interference include claims which correspond to the count which is Martin's claim 2, that does not mean Fogarty's uninvolved application 08/684,508 has at any time included a claim drawn to substantially the same subject matter as Martin's claim 2.

In its brief for final hearing, Fogarty argues that so long as it was claiming the required subject matter in some earlier application within one year of the issuance of the Martin patent, it passes muster under 35 U.S.C. § 135(b). Fogarty cites two decisions of the Court of Customs and Patent Appeals, In re Schutte, 244 F.2d 323, 113 USPQ 537 (CCPA 1981) and Corbett v. Chisholm, 568 F.2d 759, 196 USPQ 337 (CCPA 1977), two decisions of the Board of Patent Interferences, Tezuka v. Wilson, 224 USPQ 1030, 1036 (Bd. Pat. Int. 1984), Olin v. Duerr, 175 USPQ 707 (Bd. Pat. Int. 1972), and one decision of the Board of Patent Appeals and Interferences, Bowen v. Bihlmaier, 231 USPQ 662 (Bd. Pat. App. & Int. 1986), in support of its view. Fogarty points out that its uninvolved application 08/684,508 is a file wrapper continuation of application 08/255,681, to which it has been

Interference No. 104,192
Cragg v. Martin v. Fogarty

accorded benefit in this interference and with respect to which Fogarty's involved application is a divisional application.

Cragg's opposition brief does not take up and address the issue as noted above. We find Fogarty's presentation persuasive at least in the circumstances of this case. Consequently, we no longer rely on the above-quoted portion of the motion panel's decision to deny Fogarty's preliminary motion 8.

Another issue, however, nonetheless undermines and precludes the granting of Fogarty's preliminary motion 8. As was explained in the motion panel's decision on page 53:

[W]e disagree with Fogarty's contention that if a claim the same as Martin's claim 2 is made in an application, then a claim the same as Martin's claim 1 is also necessarily made, simply because Martin's claim 2 depends from Martin's claim 1 and thus includes all features of Martin's claim 1. The case cited by Fogarty, In re Schutte, 244 F.2d 323, 113 USPQ 537 (CCPA 1981), does not hold that so long as every feature of a claim is present in another claim then substantially the same subject matter is being claimed. In Schutte, no other difference between two claims is at issue, except for the one which the Court regarded as different in language but same in substance.

Fogarty's view leads to the erroneous result that a claim directed to patentably distinct and separately patentable subject matter as that of another claim can be regarded, at the same time, as claiming the same or substantially the same invention as that other claim. Party Cragg should note that Martin's claim 2 can be separately patentable and patentably distinct from

Interference No. 104,192
Cragg v. Martin v. Fogarty

Martin's claim 1 even though it depends from claim 1 and undoubtedly includes every limitation of claim 1.

Because it is important that we fully address Fogarty's arguments, we reproduce portions of Fogarty's brief below (Br. at 7-8):

Fogarty responded to Cragg's assertion of noncompliance with 35 USC § 135(b) by noting that the determination under the statute is:

[W]hether the claim which was pending had all the material limitations of the patent claim. *In re Schutte*, 244 F.2d 323, 113 USPQ 537 (CCPA 1981). If the pending claims had all the material limitations there is compliance with the statute even if different language is employed. [Fogarty Reply, p. 5, original italics]

This principle of law has been applied for at least half a century, as is apparent from the authorities cited in the last two paragraphs on page 5 of Fogarty's Reply, i.e., *Ex parte Bowen*, 80 USPQ 106 (Bd. App. 1947), *Stalego v. Heymes*, *supra*, *Olin v. Duerr*, *supra*, and *In re Schutte*, *supra*.

The decision adopted Cragg's argument but with one possible exception did not address (nor acknowledge) the precedents cited by Fogarty.

The test in each of *Bowen*, *Stalego*, *Olin* and *Schutte* for determining compliance with 35 USC § 135(b) is straight forward: is a limitation of the patent claim material and if so, is it claimed by the applicant, expressly or inherently? [Footnote omitted] Application of this test to different fact patterns is seen in a comparison of the results in, for example, (i) *Corbett v. Chisholm*, *supra*, where there was no compliance because a limitation was material but was neither disclosed nor inherent, (ii) *Bowen v.*

Interference No. 104,192
Cragg v. Martin v. Fogarty

Bihlmaier, *supra* where compliance was found because the material limitation was substantially claimed albeit in different language, (iii) *Connin v. Andrews*, 223 USPQ 243 (Bd. Pat. Int'f. 1984) where the limitation, while material and undisclosed, was inherent, and (iv) *Pizzurro v. Pfund*, 1 USPQ2d 1056 (Bd. Pat. Int'f. 1984) where a limitation was material and claimed.

In our view, none of the authorities Fogarty cites sets forth the principle that so long as every material limitation of a patent claim is included in an applicant's claim, then the applicant has claimed substantially the same invention as the patent claim, regardless of whether the applicant's claim includes additional features which may render the applicant's claim patentably distinct or separately patentable from the patent claim.

Except for *In re Tanke*, 213 F.2d 551, 102 USPQ 83 (CCPA 1954), *Stalego v. Heymes*, 263 F.2d 334, 120 USPQ 473 (CCPA 1959), *Wetmore v. Miller*, 477 F.2d 960, 177 USPQ 699 (CCPA 1973), and *Corbett v. Chisholm*, 568 F.2d 759, 196 USPQ 337 (CCPA 1977), none of the other cases cited by Fogarty⁷ for determining whether substantially the same invention was being claimed by an

⁷ Not *Rieser v. Williams*, 255 F.2d 419, 118 USPQ 96 (CCPA 1958); not *In re Schutte*, 244 F.2d 323, 113 USPQ 537 (CCPA 1981); not *Ex parte Bowen*, 80 USPQ 106 (Bd. App. 1947); not *Olin v. Duerr*, 175 USPQ 707 (Bd. Pat. Int. 1972); not *Connin v. Andrews*, 223 USPQ 243 (Bd. Pat. Int. 1984); not *Pizzurro v. Pfund*, 1 USPQ2d 1056 (Bd. Pat. Int. 1984); not *Bowen v. Bihlmaier*, 231 USPQ 662 (Bd. Pat. App. & Int. 1986).

Interference No. 104,192
Cragg v. Martin v. Fogarty

applicant discussed as an issue whether the applicant's claim contained additional features which made the application claim not substantially the same as the patent claim. Fogarty too strictly applied the principle that if every material feature of the patent claim is present in the application claim then substantially the same invention is being claimed by the applicant. The mistake lies in not recognizing that the applicant's claim may include material features that render the applicant's claim patentably distinct and separately patentable from the patent claim.

In Stalego v. Heymes, 263 F.2d 334, 335, 120 USPQ 473, 475 (CCPA 1959), the Court of Customs and Patent Appeals stated:

Those decisions [citing to precedents] hold, in effect, that claims are not for substantially the same subject matter if one of them contains one or more material limitations which are not found in the other. Accordingly, the ultimate question to be decided in such cases is generally whether specific differences between claims are material; and that is a question which must be decided largely on the basis of the particular circumstances of each case.

In Stalego, the Court reviewed the additional features of the reissue applicant's claim and stated that it did not regard any of those limitations as important. In analyzing the additional features claimed by the reissue applicant, the Court in Stalego, 263 F.2d at 338, 120 USPQ at 477, referred to one feature as not having criticality and another as adding nothing of consequence.

Interference No. 104,192
Cragg v. Martin v. Fogarty

The key is that the limitations of the applicant's claim at issue must be examined and are relevant too for materiality, not just the features of the patent claim. In Wetmore v. Miller, 477 F.2d 960, 177 USPQ 699, 701 (CCPA 1973), the Court of Customs and Patent Appeals cited to Rieser v. Williams, 255 F.2d 419, 118 USPQ 96 (1958) and Stalego v. Heymes, 263 F.2d 334, 120 USPQ 473 (1959), as setting forth the criterion that has been adopted by the CCPA for determining the applicability of section 135(b).

We do not regard Wetmore v. Miller as making any change to the criterion set forth in Stalego v. Heymes. Evidently, neither does Fogarty. In Wetmore, in light of the additional "fusible" limitation contained in the applicant's claim, the Court stated that the Board made too much emphasis on the fact that the patent claim applies to multiple embodiments and gave insufficient weight to embodiments in the patent using a heat fusible member. Note that the patent claim utilized means-plus-function features under 35 U.S.C. § 112, sixth paragraph. Clearly, the Court considered the technical significance of features in the applicant's claim in a comparison with the claim of the patentee.

In Corbett v. Chisholm, supra, and as Fogarty itself has noted, (Reply at 6, lines 19-25), in response to a restriction requirement the applicant elected to prosecute apparatus claims instead of method claims as the patentee had claimed and the

Interference No. 104,192
Cragg v. Martin v. Fogarty

patentee's method could be practiced with apparatus materially different from that which the applicant elected. On that basis, the Court held that the applicant's claim and the patentee's claim defined patentably distinct inventions. Thus, the applicant was not claiming substantially the same invention as the patentee. What this suggests is that the features claimed by the applicant, over and above that which is claimed by the patentee, are important and cannot be ignored.⁸

As for In re Tanke, 213 F.2d 551, 102 USPQ 83 (CCPA 1954), it does not hold, as Fogarty argues on page 8 of its reply, that "a mere distinction in breadth or scope" does not define a separate invention. The language of In re Tanke must be read in context. What it actually conveys is that where the subject matter of the differently claimed inventions has already been determined as being directed to substantially the same invention, the specific variations are a mere distinction in breadth or scope within the same or substantially the same subject matter and thus do not define separate inventions or inventions which are not substantially the same. Note that In re Tanke states, 213 F.2d at 555, 102 USPQ at 85:

⁸ Note also that other claims of the applicant did not include one or more material features of the patentee's claim.

Interference No. 104,192
Cragg v. Martin v. Fogarty

Furthermore, it should be noted that the terms "draft structure" defined by appellants' original claims 6 and 14, and the terms such as "drawbar-receiving member" and "bail-receiving member" in the appealed claims seem to be merely different expressions for essentially the same apparatus both structurally and functionally.

The final conclusion of the board in this case holding that the recitation of the draft structure in the appealed claims "to be different in scope from that recited in claim 14" does not appear to legally establish that such claims are not for substantially the same subject matter.

In dealing with competing claims, one group of which was drawn to a spring which assisted in both lifting and lowering certain plow beams therein defined, and another group which merely defined the function of the spring as assisting in the lifting of said beams, the Supreme Court held that both groups of claims were for the same combination; . . . and that such [one group of] claims should they consist of nothing more than a mere distinction in breadth or scope when compared to the [other group of] patented claims, do not define a separate invention or subject matter which is not substantially the same. Miller v. Eagle Manufacturing Co., 151 U.S. 186 [citations omitted]. (Emphasis added.)

Fogarty's claim 27, the same as original claim 27 in Fogarty's parent application 08/255,681 filed on June 8, 1994, was made within the one-year of November 19, 1996, the date of issuance of Martin's Patent No. 5,575,817. Even assuming that claim 27 includes every feature of Martin's dependent claim 2, and therefor it must include every feature of Martin's independent claim 1, that does not mean Fogarty had claimed substantially the same invention as Martin's claim 1. Martin's

Interference No. 104,192
Cragg v. Martin v. Fogarty

independent claim 1 formed the basis of the count in related Interference No. 104,083. Martin's dependent claim 2 forms the basis of the count in this interference (See Paper No. 16).

Martin's claim 2 adds a feature which is not present in Martin's claim 1. Fogarty had notice that the examiner regarded Martin's claim 2 as patentably distinct from Martin's claim 1. On page 3 of the examiner's Rule 1.609(b) submission, it is stated:

Distinction between Counts 1 and 2.

The important feature of count 1 [the count in Interference 104,083] is that the bifurcated prosthesis has two limbs but only one limb extends across the bifurcation and into the lumen of the vessel. Count 2 [the count in this interference] requires an additional stent to be added to the short limb, thus making a two piece graft that extends into both branches of the vessel. The count 2 is patentably distinct from count 1 for this reason.

Moreover, on page 9 of Fogarty's preliminary motion 8, Fogarty expressly recognized that the USPTO has regarded the counts of Interference No. 104,083 and this interference, represented by Martin's claims 1 and 2, as being directed to separately patentable inventions. Fogarty did not challenge that position. Instead, Fogarty stated that "[t]he same would apply to the Count of the present interference and proposed Count F-2 [for the additional interference]."

In summary, according to Fogarty, because its claim 27 was pending within the critical one-year period of 35 U.S.C. § 135(b)

Interference No. 104,192
Cragg v. Martin v. Fogarty

and because claim 27 includes every feature of Martin's dependent claim 2, and therefore Martin's independent claim 1, Fogarty was claiming substantially the same invention as Martin's claim 1 within the critical one-year period of 35 U.S.C. § 135(b). We reject Fogarty's argument, because it regards as irrelevant whether the additional feature added by Martin's dependent claim 2 renders Martin's claim 2 patentably distinct and separately patentable from Martin's claim 1. If it is, as it apparently is so based on the examiner's Rule 1.609(b) submission, a position Fogarty has not disputed and in fact urged as similarly true with the count in this interference as compared to the proposed count (see Fogarty's preliminary motion 8, Section 7 on page 9), then Fogarty cannot be deemed as claiming substantially the same invention as Martin's claim 1 by way of having a claim the same as Martin's claim 2.⁹ Fogarty has failed to demonstrate that it had been claiming substantially the same invention as Martin's claim 1 within the one-year period of 35 U.S.C. § 135(b).

3. Cragg's Assertion that claim 62 of Fogarty's uninvolved application is unpatentable under 35 U.S.C. § 112, first and second paragraphs

⁹ This is in contrast with the applicant's claiming the same patentable invention as the patentee but merely adds features which are of no criticality or significance. See Stalego v. Heymes, 263 F.2d at 338, 120 USPQ at 477.

Interference No. 104,192
Cragg v. Martin v. Fogarty

In opposing Fogarty's preliminary motion 8, Cragg never asserted that any claim of Fogarty was unpatentable for indefiniteness under 35 U.S.C. § 112, second paragraph. The brief for final hearing is not an occasion to be raising such issues for the first time. Accordingly, we decline to entertain Cragg's argument that claim 62 of Fogarty's uninvolved application is unpatentable under 35 U.S.C. § 112, second paragraph.

The motion panel's decision on preliminary motions (Paper No. 108) stated that it was manifestly apparent based on the entirety of the pleadings that claim 62 and not claim 63 of Fogarty's uninvolved application was the claim at issue in connection with Fogarty's motion to have an additional interference declared. It further found that parties Cragg and Martin would not be prejudiced by a recognition that Fogarty's motion concerned claim 62 of Fogarty's uninvolved application. While opposing Fogarty's motion, Cragg asserted that Fogarty's claims 62 and 63 are unpatentable under 35 U.S.C. § 112, first paragraph, but meaningfully discussed only the features of Fogarty's claim 63. Because nothing meaningful was presented with regard to Fogarty's claim 62, the decision on preliminary motions did not discuss Cragg's mere conclusion that Fogarty's claim 62 is unpatentable under 35 U.S.C. § 112, first paragraph.

Interference No. 104,192
Cragg v. Martin v. Fogarty

In its opposition brief at final hearing, Cragg asserts that claim 62 of Fogarty's uninvolved application 08/684,508 is unpatentable under 35 U.S.C. § 112, first paragraph, and makes a detailed analysis, for the first time, as to why the assertion has merit. This substantive analysis directed to Fogarty's claim 62 was not previously provided in Cragg's opposition to Fogarty's preliminary motion 8. Accordingly, such analysis will not be entertained for the first time at final hearing.

We will not compare Fogarty's claims 62 and 63 and attempt to figure out which features are common therebetween such that when Cragg discussed a certain feature of claim 63 when opposing Fogarty's preliminary motion 8 it was the same as if it were discussing a corresponding feature in Fogarty's claim 62. It was incumbent upon Cragg when opposing Fogarty's motion to clearly set forth why Fogarty's claim 62 is unpatentable under 35 U.S.C. § 112, first paragraph. It is not the role of the Board to act as an advocate for either party by making arguments, presentations, or comparisons which should have been made by the parties themselves.

Because no meaningful argument was presented by Cragg in its opposition to Fogarty's preliminary motion 8 as to why claim 62 of Fogarty's uninvolved application 08/684,508 is unpatentable under 35 U.S.C. § 112, first paragraph, we reject Cragg's

Interference No. 104,192
Cragg v. Martin v. Fogarty

argument at final hearing that claim 62 of Fogarty's uninvolved application 08/684,508 is unpatentable under 35 U.S.C. § 112, first paragraph.

Alternatively, even if we do consider the substantive arguments made for the first time by Cragg in its opposition brief at final hearing concerning claim 62 of Fogarty's uninvolved application 08/684,508, the arguments are without merit and do not make out a prima facie case that claim 62 of Fogarty's application 08/684,508 is without written description support in the specification.

According to Cragg, the features (1) a first leg joined to said anchor section, and (2) means for joining a second leg to said anchor section, of claim 62 of Fogarty's uninvolved application 08/684,508 are without support in the specification of application 08/684,508. Cragg contends that "Fogarty's first leg is never joined to an anchor section." Cragg explains that Fogarty's first leg is positioned within a fiber fabric liner at a location spaced below the anchor section. According to Cragg, Fogarty's second leg is also not joined to the anchor section, evidently for the same reason, and thus there can be no description for a "means for joining a second leg to said anchor section." Cragg's arguments assume that there must be direct contact between the first leg and the anchor section and between

Interference No. 104,192
Cragg v. Martin v. Fogarty

the second leg and the anchor section. We see no reason, however, to construe claim 62 of Fogarty's uninvolved application 08/684,508 so narrowly as to require direct or immediate contact between the first and second legs and the anchor section.

Cragg does not contend that Fogarty's application 08/684,508 sets forth a special definition for the word "join" that is different from the ordinary meaning of the term. We understand the word "join" as sufficiently broad to encompass an indirect connection through an intermediate member. See, for example, Merriam-Webster's Collegiate Dictionary, Tenth Edition, Copyright © 1999, which defines "join" as follows:

1 a: to put or bring together so as to form a unit . . .
 . . . b: to connect (as points) by a line c: ADJOIN 2:
 to put or bring into close association or relationship
 . . . 3: to engage in (battle) 4 a: to come into the
 company of . . . b: to associate oneself with . . .

If the first and second legs in Fogarty's application 08/684,508 are connected to the anchor section by way of a fiber fabric liner, as Cragg apparently indicates, that does not mean the first and the second legs are not joined to the anchor section. Cragg argues that the tubular liner means cannot also be the means for joining because if it is then that would render meaningless the tubular liner means element of claim 62. The argument is without merit, because the recitation of a tubular liner means in claim 62 further specifies that the liner

Interference No. 104,192
Cragg v. Martin v. Fogarty

structure defines a continuous flow path from the anchor section to the first leg and an opening disposed toward the second branch lumen. We note further that nothing precludes the same disclosed physical element from being the corresponding structure of two or more means-plus-function elements in a claim, provided that the structure performs the recited functions of those means-plus-function clauses.

4. Fogarty's argument that notwithstanding any 35 U.S.C. § 135(b) bar relative to patentee Martin, Fogarty is not precluded from having an interference with Cragg is without merit

Fogarty points out that in related Interference No. 104,083 involving only Martin and Cragg, specifically Cragg claim 89 and Martin claim 1, judgment has been entered against patentee Martin and thus claim 1 of Martin is as good as cancelled. According to Fogarty, the time bar under 35 U.S.C. § 135(b) is for protecting patentees from perpetually under threat of an interference proceeding initiated by applicants. Thus, Fogarty argues that because judgment has been entered against Martin's patent claim 1 in Interference No. 104,083, protection for Martin under 35 U.S.C. § 135(b) insofar as Martin's claim 1 is concerned is moot and unnecessary. Fogarty's view is that in this circumstance, application of the bar under 35 U.S.C. § 135(b) only protects another applicant, i.e., party Cragg, whose claim 89 would be shielded from a priority determination relative to Fogarty.

Interference No. 104,192
Cragg v. Martin v. Fogarty

While 35 U.S.C. § 135(b) was primarily enacted to protect patentees, the language of the statute is not such that only a patentee may benefit from the bar. The statutory section is written in terms of a bar on the presentation of a claim, not as a bar on having an interference with a patentee. If an applicant is time-barred by 35 U.S.C. § 135(b) from presenting a certain claim, then it follows that the barred claim cannot serve as the basis of an interference with respect to another applicant whose claim for the same patentable invention is not subject to the bar. Thus, if applicable, the bar under 35 U.S.C. § 135(b) yields an incidental benefit to potentially opposing applicants. The statutory section does not restrict or limit who may benefit from application of the bar, as it only precludes the presentation of a claim. Note that 35 U.S.C. § 135(b) has been upheld as an applicable ground of rejection in ex parte prosecution before the USPTO. In re McGrew, 120 F.3d 1236, 43 USPQ2d 1632 (Fed. Cir. 1997).

Fogarty would have us read into 35 U.S.C. § 135(b) language that is not there, to turn it into a bar against having certain types of interferences instead of simply a bar on the presentation of certain claims as it so plainly reads. We decline to so distort or add to the statutory language. In our

Interference No. 104,192
Cragg v. Martin v. Fogarty

view, if Fogarty cannot present a claim, then it cannot have an interference based on that claim with another party, whether that other party is an applicant or a patentee.

Fogarty's claim 62 was presumed by the parties as being for substantially the same invention as Martin's patent claim 1. Because it was presented outside of the one year period from the date of issuance of the Martin patent, and because Fogarty can demonstrate no other claim which was pending prior to the one year period and which was directed to substantially the same invention as Martin's claim 1, Fogarty's claim 62 is barred.

The fact that Martin's patent claim 1 has been determined unpatentable to Martin because of an adverse judgment in Interference No. 104,083 does not help Fogarty. The language of 35 U.S.C. § 135(b) refers to a claim for the same or substantially the same subject matter as "a claim of an issued patent" and does not purport to add the qualifications that such a claim must remain valid, non-canceled, patentable, non-disclaimed, and/or enforceable. We decline to read into 35 U.S.C. § 135(b) these conditions in the absence of a showing by Fogarty of a clear legislative intent to that effect. The operative word is "issued," similar to the word "born." Just as a baby cannot be un-born, an issued claim cannot become non-issued whatever its status becomes subsequent to issuance.

Interference No. 104,192
Cragg v. Martin v. Fogarty

The public's interest is not harmed by applying 35 U.S.C. § 135(b) the way it is written and enacted by Congress. Fogarty is also under a mistaken belief that it is prejudiced by its not being successful with preliminary motion 8 to get into an interference with Cragg who has a dominating claim. Fogarty's predicament arises from its not having established, in connection with a proposed new interference involving Cragg's claim 89, interference-in-fact with respect to a Fogarty claim that is not time barred under 35 U.S.C. § 135(b). Alternatively, if Fogarty believes that Cragg's dominating claim 89 and any Fogarty claim involved in this interference define the same patentable subject matter, Fogarty could have moved to broaden out the count in this interference to the scope of Cragg's claim 89 and to have Cragg's claim 89 designated as corresponding to the revised new count. Fogarty did not take such action in this case. On these circumstances, that Cragg has a dominating claim not involved in this interference or a new interference with Fogarty does not mean Fogarty has been subjected to prejudice. A dominating claim is not necessarily a claim drawn to the same patentable invention as a dominated claim. In either case, however, with regard to Cragg's allegedly dominating claim 89 Fogarty has shown no prejudice by the denial of its preliminary motion 8.

Interference No. 104,192
Cragg v. Martin v. Fogarty

5. Fogarty's preliminary motion 10

Fogarty's preliminary motion 10 sought to be accorded benefit of the earlier filing date of application 08/255,681, with respect to the count proposed in connection with Fogarty's preliminary motion 8. Consequently, preliminary motion 10 is contingent upon the granting of preliminary motion 8. Because Fogarty's preliminary motion 8 was properly denied, Fogarty's preliminary motion 10 was correctly dismissed as moot.

6. Cragg's Motion to Suppress

Cragg has filed a motion to suppress five exhibits FE-3001, FE-3002, FE-3004, FE-3005, and CE-1019. These are exhibits identified by party Fogarty, prior to submission of its brief at final hearing, as those which Fogarty intended to rely upon at final hearing in connection with its seeking review of the motion panel's decision of Fogarty's preliminary motion 8. According to Cragg, Fogarty may not rely on these exhibits at final hearing because Fogarty did not rely on these exhibits when filing its preliminary motion 8.

Cragg has not pointed out, and it is not immediately apparent, where in Fogarty's briefs at final hearing are references made to exhibits FE-3001, FE-3002, FE-3004, FE-3005, and CE-1019, or how the substance of these exhibits have been relied upon by Fogarty in meaningful furtherance of any argument.

Interference No. 104,192
Cragg v. Martin v. Fogarty

Thus, with regard to these exhibits, Cragg has failed to make out a prima facie case of why the motion to suppress should be granted. Alternatively, even without suppressing these exhibits, Fogarty's arguments concerning its preliminary motions 8 and 10 have not been shown to have merit. Accordingly, Cragg's motion to suppress is denied and alternatively dismissed as moot.

C. Cragg's Preliminary Motion 1

In Cragg's preliminary motion 1, it is alleged that Fogarty's claims 41-69, not all of Fogarty's claims corresponding to the count, are unpatentable under 35 U.S.C. § 112, first paragraph, for lack of written description in the specification. Fogarty's claims 42-69 depend either directly or indirectly from claim 41. Cragg's preliminary motion 1 (Paper No. 39, pp. 6-7) specifically identified the following feature of Fogarty's method claim 41 as that which is without written description:

[I]ntroducing into a patient's vasculature an anchor section and first tubular graft of the vascular graft so that the anchor section is disposed within the primary artery and the first tubular graft is disposed within the first branch artery to form a first continuous flow path from the primary artery to the first branch artery.

According to Cragg's preliminary motion 1, the above-quoted feature of Fogarty's method claim 41 requires the anchor section and the first tubular graft to be introduced in a single step, not sequentially as is disclosed in Fogarty's specification. We

Interference No. 104,192
Cragg v. Martin v. Fogarty

reproduce the following paragraph from page 10 of Cragg's preliminary motion 1, which clearly reveals Cragg's position:

The Fogarty Application fails to suggest introducing an anchor section and first tubular graft in a single step. Instead, the Fogarty Application teaches (1) first introducing the bifurcated base structure so that the anchor section is positioned within a primary vessel; (2) *after the bifurcated base structure is anchored*, the first tubular graft is introduced into the first connector leg and anchored between the leg and the first branch artery; and (3) the second tubular graft is then inserted into the second connector section and anchored between the described second connector and the second branch artery. See Fogarty Application at Page 6, lines 1-9. (Emphasis in original).

The decision on preliminary motions rejected Cragg's argument, stating (Paper No. 108, p. 10):

We reject Goicoechea's [Cragg's] argument because we do not read or interpret the above-quoted language of claim 41 as requiring that the anchor section and the first tubular graft be introduced "in a single step" or simultaneously. The words "in a single step" do not appear in claim 41, nor do the words "simultaneously," "concurrently," "unison," or any other term which means the same. The language is simply broadly recited and imposes no particular order for the insertion of the anchor section and the first tubular graft.

In its principal brief at final hearing, Cragg does not continue to argue that Fogarty's claim 41 requires that the anchor section and the first tubular graft be introduced in a single step or simultaneously. Rather, a new argument is made through the back door that the claim is so broad that the full

Interference No. 104,192
Cragg v. Martin v. Fogarty

scope of what is claimed is not described in the specification. Specifically, on page 20 of its brief, in a section entitled "CRAGG MOTION 1 SHOULD BE GRANTED," Cragg states:

If the Board adheres to its broad construction of claim 41 [that no specific sequence of introduction is required], then the Fogarty specification lacks written description for claim 41 because as discussed it only describes the sequential introduction of the anchor section and the first tubular graft but not the introduction of the anchor section and first tubular graft as a unitary structure. There is nothing in the Fogarty application to convey to those skilled in the art that Fogarty was in possession of that aspect of the invention of claim 41, if claim 41 is broadly construed as proposed.

We have again reviewed Cragg's preliminary motion 1 (Paper No. 39). Nothing therein can reasonably be considered as an alternative or contingent argument that if the Board is not persuaded by Cragg's primary argument that Fogarty's claim 41 requires the introduction of the anchor section and the first tubular graft in a single step then the claim is nonetheless not described in the specification because of undue breadth. In the case of Cragg's preliminary motion 1, the one argument actually made is the only argument made. Consequently, the issue now raised by Cragg at final hearing was neither developed and briefed by the parties during the preliminary motions stage of this interference, nor considered by the motions panel when preliminary motions were decided.

Interference No. 104,192
Cragg v. Martin v. Fogarty

In short, Cragg wants the board to now hold Fogarty's claims 41-69 as being without written description in the specification for a reason other than that articulated and set forth by Cragg in its preliminary motion 1. We decline to consider this new argument at the final hearing stage of the proceeding. Final hearing under the interference rules is not a place to begin preliminary motions afresh. Rather, we are here to review the decision by a three-member motions panel on preliminary motions made by the parties, on the evidence and arguments which formed the basis of the decision on preliminary motions.

A new reason for granting a motion should not be considered at final hearing if it was not included in the original motion and not supported by a showing of good cause why the argument was not earlier presented. Fredkin v. Irasek, 397 F.2d 342, 346, 158 USPQ 280, 284 (CCPA 1968); Koch v. Lieber, 141 F.2d 518, 520, 61 USPQ 127, 129 (CCPA 1944); Bayles v. Elbe, 16 USPQ2d 1389, 1391 (Bd. Pat. & Int. 1990) ("It has been a longstanding practice that a party whose motion was denied cannot present at final hearing grounds not included in the original motion."). It is inappropriate for a party to present arguments in its brief which were not a part of the motion or opposition. Lawson v. Enloe, 26 USPQ2d 1594 (Bd. Pat. App. & Int. 1992).

Interference No. 104,192
Cragg v. Martin v. Fogarty

All reasons for granting a party's desired relief should be advanced in the party's motion. A piecemeal presentation in which a party may start over with new arguments after an adverse decision has been rendered would make an orderly proceeding next to impossible to conduct. Cragg's brief offered no excuse for raising the issue of undue breadth issue so late, more than two years after the filing of Cragg's preliminary motion 1 on October 16, 1998, and ten months after the decision on preliminary motions has been rendered.

Cragg cannot credibly assert that it had no idea that Fogarty's claim 41 can possibly be construed so as to not require the introduction of the anchor section and the first tubular graft in a single step or simultaneously. As the moving party, Cragg was attempting to persuade the Board to adopt a narrow interpretation of Fogarty's claim 41, i.e., that the claim required the introduction of the anchor section and the first tubular graft in a single step or simultaneously. The mere filing of Cragg's motion reflects an awareness that the claim may not be so construed. Cragg was very much on notice that the Board may not adopt the narrow interpretation urged by Cragg. Cragg may not credibly claim to have been blind-sided by the Board's not adopting its position.

Interference No. 104,192
Cragg v. Martin v. Fogarty

An interference is an inter partes proceeding. The Board may not suitably act as an advocate for either party, either to fill in gaps left open in either party's presentation, or to offer an alternate rationale and to try to fit the facts to that rationale, all on its own, particularly when the considerations are complex and the parties may well differ in their views. In presenting a preliminary motion for judgment, a party may not simply plead a statutory section, e.g., 35 U.S.C. § 112, first paragraph, and then rely on the Board to propose different ways in which the opponent's claims may possibly be attacked as being without written description in the specification. With regard to Cragg's preliminary motion 1, our decision on preliminary motions addressed the arguments made by Cragg. The new argument now presented by Cragg is not entitled to consideration.

For the foregoing reasons, the motions panel properly denied Cragg's preliminary motion 1.

D. Cragg's Preliminary Motion 2

We adopt in its entirety the discussion in our decision on preliminary motions (Paper No. 108), which is reproduced below, and then add a few more comments to address Cragg's brief at final hearing:

Interference No. 104,192
Cragg v. Martin v. Fogarty

By this motion, Goicoechea [Cragg] alleges that there is no interference-in-fact between its involved application 08/461,402 and Fogarty's involved application 08/463,836. As is stated in 37 CFR § 1.601(j):

An interference-in-fact exists when at least one claim of a party that is designated to correspond to a count and at least one claim of an opponent that is designated to correspond to the count define the same patentable invention.

In that regard, 37 CFR § 1.601(n) states:

Invention "A" is the same patentable invention as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a separate patentable invention with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". (Emphasis in original.)

Resolution of an interference-in-fact issue involves a two-way patentability analysis. For there to be an interference-in-fact, the parties must each have at least one claim which collectively satisfy the following: The claimed invention of Party A must anticipate or render obvious the claimed invention of Party B and the claimed invention of Party B must

Interference No. 104,192
Cragg v. Martin v. Fogarty

anticipate or render obvious the claimed invention of Party A.

For a showing of no-interference-in-fact, the burden is on Goicoechea as the movant, see, e.g., 37 CFR § 1.637(a), to demonstrate that all of Goicoechea's claims 55, 59, 62-65, 88 and 90 which correspond to the count do not define the same patentable invention as any one of Fogarty's claims 27-69, or that all of Fogarty's claims 21-69 do not define the same patentable invention as any one of Goicoechea's claims 55, 59, 62-65, 88 and 90. Goicoechea has attempted to show that all of its claims 55, 59, 62-65, 88 and 90 define an invention process which is neither anticipated nor obvious over any one of Fogarty's claims 27-69.

Goicoechea argues that all of its claims include a "long-leg, short-leg" concept which is absent from and not suggested by any one of Fogarty's claims corresponding to the count. Also, apparently referring to the count, the motion on page 10 explains the subject matter "supposedly" in conflict as follows:

The invention that is the subject of this Interference relates to a two-section apparatus comprising (1) a first section configured to be positioned within a

bifurcated lumen and (2) a second section configured to be positioned separately in a branch of the bifurcated lumen and to extend into the bifurcated lumen. A first lower limb of the first section is configured so that it extends into a first leg of the bifurcation when the first section is positioned in the lumen. A second lower limb of the first section, which is shorter than the first lower limb, is configured so that it does not extend into a second leg of the bifurcation. Accordingly, the first section defines a "long-leg, short-leg" concept. Joining two components (the first and second sections) completes the apparatus. (Emphasis in original).

Of all Goicoechea claims which correspond to the count, claims 55, 59 and 90 are independent claims. Claim 90 is identical to the count. Claim 55 embodies the "long-leg, short-leg" idea by including step (a) -- disposing said proximal portion of said bifurcated prosthesis in said blood vessel such that said first distal portion of said bifurcated prosthesis extends into said first branched vessel [long-leg], and step (c) -- attaching said second prosthesis to said extension portion of said bifurcated prosthesis such that said second prosthesis extends into said second branched vessel [short-leg]. But claim 59 is broad and does not do the same. In that regard, claim 59 is reproduced below:

Interference No. 104,192
Cragg v. Martin v. Fogarty

59. A bifurcated prosthesis for use with an aneological bifurcation of a blood vessel into two branched vessels comprising a bifurcated proximal portion adapted to be disposed within said blood vessel, a distal portion adapted to extend across the bifurcation into one of the branched vessels, and a separate distal segment joined to said proximal portion and adapted to allow blood to flow from the proximal portion into the other branched vessel.

Goicoechea has not shown that claim 59 requires that whenever the proximal portion is placed within the blood vessel, the first distal portion is already attached to the proximal portion and extending from the blood vessel into a branched vessel and the second distal segment is not yet joined to the proximal portion. Indeed, claim 59 is broad enough to cover the case of two short-legs, i.e., the proximal portion is introduced into the blood vessel first, and then the first distal portion and the second distal segment are introduced in sequence, each extending into a respective branched blood vessel.

For the foregoing reasons, the patentable distinction argued by Goicoechea does not exist with respect to at least Goicoechea's independent claim 59. That alone is sufficient ground to reject Goicoechea's motion for no interference-in-fact. Additionally, with

Interference No. 104,192
Cragg v. Martin v. Fogarty

respect to Fogarty's claims 41-69, Goicoechea is improperly reading into those claims a specific embodiment from Fogarty's disclosure rather than focusing on the language of the claims themselves. As we discussed in the context of Goicoechea's preliminary motion 1, Fogarty's independent claim 41 is broadly recited and imposes no particular manner for the insertion of the anchor section and the first tabular graft.

Given Fogarty's claim 41, it is left to the discretion of one with ordinary skill in the art just how to introduce the anchor section and the first tubular graft. One with ordinary skill in the art possesses a certain basic level of skill. See, e.g., In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985) ([Applicant's] argument presumes stupidity rather than skill). A conclusion of obviousness also may be made based on the common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545, 549 (CCPA 1969). It cannot be reasonably argued that one with ordinary skill in the art is so devoid of skill and

Interference No. 104,192
Cragg v. Martin v. Fogarty

common sense that he or she would not have readily recognized that the anchor section and the first tubular graft may either be separately inserted and then joined in situ, or inserted as a unitary whole. Those are the only two possibilities with regard to the insertion of the anchor section and the first tubular graft. In our view, selecting one of the two readily apparent choices would have been well within the basic level of skill and common sense possessed by one with ordinary skill in the art. Moreover, it is incumbent upon Goicoechea as the movant to establish why, given Fogarty's independent claim 41, one with ordinary skill in the art would not have known that the anchor section and the first tubular graft can be inserted as one or separately. Goicoechea set forth no persuasive reasons in that regard.

For the foregoing reasons, Goicoechea has failed to demonstrate that all of its claims 55, 59, 62-65, 88 and 90 do not define the same patentable invention as any one of Fogarty's claims 27-69. Goicoechea's preliminary motion 2 insofar as it seeks a judgment based on no interference-in-fact is denied.

Interference No. 104,192
Cragg v. Martin v. Fogarty

As for Goicoechea's assertion that Fogarty's claims 27-69, all of Fogarty's claims which have been designated as corresponding to the count in the declaration of this interference, do not correspond to the count, Goicoechea has to satisfy the requirements set forth in 37 CFR § 1.637(c)(4). Goicoechea has to show that each of Fogarty's claims 27-69 does not define the same patentable invention as any of Goicoechea's claims and Martin's claims whose correspondence to the count Goicoechea does not dispute.

As is already discussed above in connection with Goicoechea's assertion of no interference-in-fact, Goicoechea has not established patentable distinction between Fogarty's claims 41-69 and at least Goicoechea's claim 55 and claim 90, and also between Fogarty's claims 27-69 and at least Goicoechea's claim 59. Goicoechea's preliminary motion 2 to designate Fogarty's claims 27-69 as not corresponding to the count is denied.

Nothing presented by Cragg in its brief at final hearing demonstrates that our above-quoted analysis was in error. Fogarty is correct that Cragg continues to attempt an

Interference No. 104,192
Cragg v. Martin v. Fogarty

inappropriate reading of extraneous limitations from the specification into the claims. Although the specification is useful in interpreting claim language, as the Court of Appeals for the Federal Circuit has nonetheless stated, "the name of the game is the claim." In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). See also Giles Sutherland Rich, Extent of Protection and Interpretation of Claims--American Perspectives, 21 Int' Rev. Indus. Prop. & Copyright L, 497, 499 (1990) ("The U.S. is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claims."). Reading into the claims an extraneous limitation from the specification is simply improper. E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir. 1988). In E.I. de Pont, 849 F.2d at 1433, 7 USPQ2d at 1131, the Federal Circuit stated:

It is entirely proper to use the specification to interpret what the Patentee meant by a word or phrase in the claim. See, e.g., Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 867, 228 USPQ 90, 93 (Fed. Cir. 1985). But this is not to be confused with adding an extraneous limitation appearing in the specification, which is improper. By "extraneous," we mean a limitation read into a claim from the specification wholly apart from any need to interpret what the patentee meant by particular words or phrases in the claim.

Interference No. 104,192
Cragg v. Martin v. Fogarty

In interpreting its own claims, Cragg in its brief at final hearing begins with a section discussing its disclosure, entitled "Cragg Discloses A Unitary Bifurcated Long Leg/Short Leg Prosthesis" (Emphasis in original). That section ends with this one sentence paragraph:

The specification supports that Cragg's claims require a unitary bifurcated long leg/short leg structure, where "unitary" requires a securing means connecting the portions of the structure.

By the time Cragg made the above-quoted conclusion, it has not yet recited, reproduced, or even referred to any actual language in its claims. That Cragg's specification has a description for a certain embodiment does not necessarily mean that all of Cragg's claims must include the elements of that embodiment. If the claims do not require a unitary structure in the sense that there is a securing means which connects all the parts together, these are extraneous limitations which should not be read into the claims from the specification. Moreover, even Cragg's own specification contains no reference to the term "unitary" on which Cragg now places so much emphasis. Neither does Cragg's own specification contain any reference to words which are generally synonymous with the word "unitary," such as "integral"

Interference No. 104,192
Cragg v. Martin v. Fogarty

or "one-piece." Thus, what Cragg is arguing in this part is many steps removed from the actual language of the claims.

The bifurcated prosthesis according to Cragg's claim 59 requires (1) a proximal portion, (2) a distal portion, and (3) a separate distal segment. Unlike Cragg's claim 55, Cragg's claim 59 does not require disposing the proximal portion in the blood vessel such that the distal portion extends into a first branched vessel. That means claim 59 is sufficiently broad to have the proximal portion put in place without regard to whether the distal portion is also placed in working position.

Cragg argues that because the word "portion" means part of a whole, the proximal portion and the distal portion must be part of a unitary structure in which the proximal portion and the distal portion is unitary or connected together by some securing means before being introduced into the blood vessel. We are not persuaded by Cragg's argument.

While the word "portion" may indeed mean part of a whole or part of something, Cragg has not submitted any evidence that the so called parts of a whole must be physically attached to each other at all times. In that regard, note that a jig-saw puzzle has many parts or portions but the many pieces don't have to be connected to each other before properly being referred to as portions of the same puzzle. Cragg has not made any meaningful

Interference No. 104,192
Cragg v. Martin v. Fogarty

showing that the word "portion" as is ordinarily used in the English language requires an actual physical attachment. Nor has Cragg argued that its specification has specially defined the word "portion" in a manner different from its ordinary usage in the English language. Indeed, Cragg even cites to Merriam Webster's Collegiate Dictionary, 10th Ed. (1994) in its brief at final hearing for the meaning of "portion," which states: "part of something." Note that "part of something" can be conceptual and does not necessarily require a physical connection at all times. Moreover, we note that even Cragg's so called "portions" are not physically connected at all times; indisputably, they have to be preassembled prior to introduction into the patient.

Alternatively, our decision on preliminary motion held that even assuming that the "unitary" feature argued by Cragg is included in all of Cragg's claims corresponding to the count, Fogarty's claim 41 still would have rendered obvious Cragg's claimed invention such as Cragg's claim 59.

Cragg argues (Br. at 18):

The Board states that insertion of the anchor section and the first tubular graft as a unitary whole is only one of two possibilities with regard to the insertion of the Fogarty structure. Paper No. 108, p.15. There is a third possibility ignored by the Board, namely, inserting the anchor section and both tubular grafts at the same time.

Interference No. 104,192
Cragg v. Martin v. Fogarty

The argument is without merit. We stated (Paper No. 108, at 15) that there are "only two possibilities with regard to the insertion of the anchor section and the first tubular graft" (emphasis added). In that context, the second tubular graft is uninvolved, and how it is introduced is irrelevant.

We adopt and reiterate herein the following portion of our decision on preliminary motions concerning Cragg's preliminary motion 2 (Paper No. 108, pp. 14-16):

Additionally, with respect to Fogarty's claims 41-69, Goicoechea is improperly reading into those claims a specific embodiment from Fogarty's disclosure rather than focusing on the language of the claims themselves. As we discussed in the context of Goicoechea's preliminary motion 1, Fogarty's independent claim 41 is broadly recited and imposes no particular manner for the insertion of the anchor section and the first tubular graft.

Given Fogarty's claim 41, it is left to the discretion of one with ordinary skill in the art just how to introduce the anchor section and the first tubular graft. One with ordinary skill in the art possesses a certain basic level of skill. See, e.g., In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985) ([Applicant's] argument presumes stupidity rather than skill). A conclusion of obviousness also may be made based on the common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545, 549 (CCPA 1969). It cannot be reasonably argued that one with ordinary skill in the art is so devoid of skill and common sense that he or she would not have readily recognized that the anchor section and the first tubular graft may either be separately inserted and then joined in situ, or inserted as a unitary whole.

Interference No. 104,192
Cragg v. Martin v. Fogarty

Those are the only two possibilities with regard to the insertion of the anchor section and the first tubular graft. In our view, selecting one of the two readily apparent choices would have been well within the basic level of skill and common sense possessed by one with ordinary skill in the art. Moreover, it is incumbent upon Goicoechea as the movant to establish why, given Fogarty's independent claim 41, one with ordinary skill in the art would not have known that the anchor section and the first tubular graft can be inserted as one or separately. Goicoechea set forth no persuasive reasons in that regard.

Cragg dismisses our citation to In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985) and In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969), by arguing that "[b]oth Bozek and Sovish required a disclosure in the prior art references to render the claims obvious."). It appears that Cragg completely misses the point for which we cited to those cases, i.e., that one with ordinary skill in the art is presumed to possess some logic and skill that is independent of what is disclosed in an item of prior art. Here, the starting point is Fogarty's claim 41. In that sense, Fogarty's claim 41 is the disclosure with which one with ordinary skill in the art is presented, in determining whether claims such as Cragg's claim 59 would have been obvious over Fogarty's claim 41. We agree entirely with the following two paragraphs in Fogarty's opposition brief at pages 14-15:

Second, while Cragg would argue that Sovish and Bozek are somehow anomalous, the principle for which

Interference No. 104,192
Cragg v. Martin v. Fogarty

they were actually cited in the Decision has been repeatedly followed by this Board; e.g., Ex parte Research and Manufacturing Co., 10 USPQ2d 1657, 1664 (Bd. Pat. App. & Intf. 1989) (skill is presumed on the part of the artisan rather than the converse); Ex parte George, 21 USPQ2d 1058, 1060 n.1 (Bd. Pat. App. & Int. 1991) (the ability of one having ordinary skill in the art should not be underestimated); Ex parte Nesbit, 25 USPQ2d 1817, 1823 (Bd. Pat. App. & Intf. 1992) (the law presumes skill on the part of the artisan rather than the converse); Ex parte GPAC Inc., 29 USPQ2d 1401, 1405 (Bd. Pat. App. & Intf. 1993) (the skill of the art must be presumed, not the contrary).

The Board thus found that the worker is not so devoid of skill or common sense that he or she would not have readily recognized that the anchor section and the first tubular graft may either be separately inserted and then joined *in situ*, or inserted as a unitary whole. (Emphasis in original).

Cragg's citation to Al-Site Corp. v. VSI Intern., Inc., 174 F.3d 1308, 1323, 50 USPQ2d 1161 (Fed. Cir. 1999) is inapposite. The Al-Site case does not stand for the proposition that Fogarty's claim 41 must be combined with another prior art reference in order to render obvious a Cragg claim which corresponds to the count. In contrast, the case supports the position that the perspective from which a prior art reference is viewed is that of a person with ordinary skill in the art.

Cragg further argues that the Board has not explained how, if Fogarty's anchor section and first tubular graft are inserted as one piece, a skilled worker would successfully position that device. According to Cragg, because the first tubular graft of

Interference No. 104,192
Cragg v. Martin v. Fogarty

Fogarty is within the fabric liner leg 28, one ends up with an anchor section-fabric liner-tubular graft assembly that is not rigid and is not supported. The argument is misdirected and in any event unpersuasive. Here, the starting point for the obviousness analysis is not some embodiment disclosed in Fogarty's specification, but Fogarty's claim 41 which does not require placing the first tubular graft in a fabric liner leg. Moreover, in any event Cragg has submitted no meaningful evidence in the form of declaration or affidavit testimony from anyone to establish that one with ordinary skill in the art would not have known how to introduce the anchor section together with the first tubular graft. As Fogarty has pointed out in its opposition brief, attorney argument cannot take the place of evidence lacking in the record. See, e.g., Knorr v. Pearson, 671 F.2d 1368, 1373, 213 USPQ 196, 200 (CCPA 1982); Meitzner v. Mindick, 549 F.2d 775, 782, 193 USPQ 17, 22 (CCPA), cert. denied, 434 U.S. 854, 195 USPQ 465 (1977); In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972).

Cragg's preliminary motion 2 further seeks to have all of Fogarty's claims corresponding to the count, i.e., claims 27-69, designated as not corresponding to the count. We ruled in the decision on preliminary motions that per 37 CFR § 1.637(c)(4), the motion is without merit because it failed to demonstrate that

Interference No. 104,192
Cragg v. Martin v. Fogarty

each of Fogarty's claims 27-69 does not define the same patentable invention as any of Cragg's claims and Martin claims whose correspondence to the count is not disputed by Cragg.

Cragg's arguments with regard to designating Fogarty's claims as not corresponding to the count is merely a reference to its arguments alleging no interference-in-fact between Cragg's claims and Fogarty's claims. Cragg evidently is of the view that if it has demonstrated no interference-in-fact between its claims and Martin's claims on the one hand and Fogarty's claims on the other hand, then the case has been made that Fogarty's claims corresponding to the count should be designated as not corresponding to the count. But Cragg has failed to demonstrate no interference-in-fact between its claims and Martin's claims on the one hand and Fogarty's claims on the other hand. Thus, no reason has been shown to designate Fogarty's claims 27-69 as not corresponding to the count. Note also that even if there was no interference-in-fact with respect to any Fogarty claim, Fogarty's application would become uninvolved and there would be no need to designate any of its claims as not corresponding to the count.

For the foregoing reasons, Cragg has shown no error in the denial of Cragg's preliminary motion 2.

Interference No. 104,192
Cragg v. Martin v. Fogarty

Judgment

It is

ORDERED that judgment as to the subject matter of the count is herein entered against junior party ERIC C. MARTIN and also against junior party ANDREW H. CRAGG and MICHAEL D. DAKE;

FURTHER ORDERED that the junior party ERIC C. MARTIN is not entitled to his patent claims 2-17 which correspond to the count;

FURTHER ORDERED that junior party ANDREW H. CRAGG and MICHAEL D. DAKE are not entitled to their application claims 55, 59, 62-65, 88 and 90 which correspond to the count; and

FURTHER ORDERED that a copy of this paper shall be given a paper number and filed in the respective involved application/patent of the parties.¹⁰

¹⁰ Failure to file a copy of any agreement regarding the termination of this proceeding may render the agreement and any resulting patent unenforceable. See section 35 U.S.C. § 135(c) and 37 CFR § 1.661.

Interference No. 104,192
Cragg v. Martin v. Fogarty

mgk

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Cragg v. Martin v. Fogarty

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